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IN THE

Supreme Court of the United States

October Term, 1965
No. 413

SHELDON L. POLLACK and MAX E. ADAMS,
Petitioners,

vs.

COMMISSIONER OF PATENTS,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

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To the Honorable Chief Justice of the Supreme Court of the United States and to the Honorable Associate Justices Thereof:

Your petitioners respectfully petition for a writ of certiorari directed to the United States Court of Appeals for the District of Columbia to bring up and to consider and reverse the judgment of that court and the District Court of Columbia in denying a patent to the petitioners for a novel and highly successful method of erecting a high strength grout filled metal reinforced brick wall, particularly in earthquake country, and to consider and define the meaning of a "*trial de novo*" and to consider and to hold that trying a patent case "de novo" the effect of the presumption of correctness of the decision of the Patent Office contrary to the intent of Congress in enacting Section 145 of Title 35 and is a denial of due process of law guaranteed by the Fifth Amendment to the Constitution of the United States.

Jurisdiction.

Jurisdiction is conferred by Title 28, Section 1254, U.S. Code.

The decision of the Court of Appeals was rendered April 8, 1965. This petition for certiorari is being filed within 90 days.

Opinion Below.

The decision of the United States District Court for the District of Columbia and the opinion of the United States Court of Appeals for the District of Columbia are attached hereto as Appendix A and Appendix B, respectively.

Statutes Involved.

Fifth Amendment, United States Constitution;

"No person shall be . . . deprived of life, liberty, or property, without due process of law . . ."

Sixth Amendment—Calif.

Amendment 6

In all criminal prosecutions, the accused shall enjoy the right to a speedy and public trial, by an impartial jury of the State and district wherein the crime shall have been committed, which district shall have been previously ascertained by law, and to be informed of the nature and cause of the accusation; to be confronted with the witnesses against him; to have compulsory process for obtaining witnesses in his favor, and to have the Assistance of Counsel for his defense.

Title 35, Section 145, U.S. Code:

"An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decisions, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant."

Questions Presented.

1. Whether the invention of a grout filled monolithic wall, encompassing uncoated brick, uncoated tie rods and uncoated supporting steel and answering a high need and highly useful *in earthquake country* is of such a novel and useful and needed character that it, together with its commercial success, in absence of commercial success of other competing or prior developed walls, entitles the inventor to a patent.

2. Whether commercial success of this invention and for commercial failure of prior art is a factor to be considered by the Court of Appeals as well as the trial court on whether the invention should receive a patent.

3. Whether the petitioner was denied due process of law guaranteed by the Fifth Amendment to the Con-

stitution of the United States when the Patent Office relied solely upon the presumption of the determination of the Patent Office without presenting any witnesses subject to examination and cross-examination.

4. Whether, under Title 35, Section 145, U.S.C., petitioners were entitled to a "trial *de novo*" in which all of the witnesses, including any witnesses who may have any facts in connection therewith from the Patent Office, were called.

5. Whether the denial of the right of cross-examination of the Patent Office witnesses and the denial of the right to be confronted by them and to cross-examine them is a denial of due process of law under the Fifth Amendment to the Constitution of the United States and of a trial on the merits as guaranteed by the Fifth, Sixth and Seventh Amendments to the Constitution of the United States.

6. Whether recognition of novelty and utility by cities and the State to gear their building code to include this new method of construction and use of walls reproduced thereby is evidence of patentability.

The Facts.

The invention claimed by the petitioners in their patent application relates to a monolithic earthquake resistant building wall and is set forth in the specifications and claims and drawings reproduced in the Joint Appendix, pages 123-136c. Only two claims are involved: Claims 17 and 18.[1] The Patent Office denied a patent.

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[1] "17. The method of erecting a high strength grout filled metal reinforced brick wall comprising the steps of: erecting vertical metal reinforcement members; placing a plurality of horizontal

Thereupon, petitioners sought a trial *de novo* in the District Court, as provided by Title 35, Section 145. U.S.C. The Patent Office did not produce any witnesses and none of their so-called experts or technicians were produced for examination or cross-examination. The petitioners produced as a witness Robert E. Franklin, a consulting structural engineer, qualified by Master of Science in Civil Engineering, his registration as a civil and structural engineer in California and elsewhere, and an engineering teacher at various universities.

Mr. Franklin testified that there had long been a need for a low-cost method of providing earthquake resistant structures (J. A. 64, 65). It was established that there were many areas of the United States in which earthquake stresses on building structures occurred. These areas stretched from Maine to California and Washing-

---

layers of pairs of bricks on top of one another to provide two parallel vertical brick walls so positioned that said metal reinforcement members are disposed approximately midway between the opposed parallel surfaces of said brick walls, each of said pairs of bricks being held in spaced parallel relationship to each other by metal connecting means having a strength greater than that of material of said bricks, and a cross section small in comparison to the length and height of said bricks; and thereafter filling the space between said walls and surrounding said metal connecting means and said vertical metal reinforcement members with grout thereby forming a unitary monolithic reinforced wall structure."

"18. A unitary monolithic wall construction comprising: a plurality of vertical metal reinforcement members; two vertical brick walls having opposed parallel surfaces including a plurality of horizontal layers of pairs of bricks located on top of one another and disposed approximately the same distance from and on opposite sides of said reinforcement members, each pair of said parallel bricks having metal connecting means to hold said bricks in spaced parallel relation to each other, said connecting means having a strength greater than that of the material of said bricks and a cross section small in comparison to the length and height of said bricks; and grout located in the space between the opposed parallel surfaces of said walls and surrounding said connecting means and said vertical metal reinforcement members."

ton (Exhibit 3, J. A. 178-D and Exhibit 4). The need for a low-cost earthquake type construction has existed throughout recorded history of construction and particularly in the West since the disastrous earthquakes in San Francisco of 1905, in Long Beach of 1933, and in Helena, Montana of 1935. It was undisputed that the Pollack and Adams wall met the qualifications for an earthquake resistant building wall and at low cost. It was expressly approved by numerous cities, including the city of Long Beach (Exhibit 7, J. A. 179, 183 and City of Los Angeles, Exhibit 8, J. A. 181), as a building wall. It is uncontradicted from the testimony of Mr. Franklin that the Pollack and Adams method produced an unusual and surprising result (J. A. 66, 86). The Pollack and Adams wall was established by the record before the trial court as a monolithic building wall "because the grout mix and the face shell units are firmly bonded together and because the grout and reinforcing steel is firmly bonded together, so that all the elements of the wall, whether the elements be large or small, must react on strain and stress together . . . so that the wall acts as a unit" (J. A. 68-72). Exhibits were offered showing numerous buildings constructed in accordance with the claims in plaintiffs' application (J. A. 82-85, 185-191, and Exhibits 12, 13, and 14). Mr. Franklin expressly testified and without contradiction that the Pollack and Adams method filled the need for a low-cost method of earthquake resistant construction (J. A. 85).

Mr. Franklin testified that a method known as the Hild method of construction differed in that the inside faces of the wall are covered with waterproofing materials to keep the weather out and the steel elements themselves have either been galvanized or painted with

red lead or some other materials to prevent corrosion. The space in between the two parallel brick walls is not filled with grout except in the foundation. Even the foundation is not monolithic because there is no bond between the grout and the wall because of the waterproofing membrane and no bond between the grout and the reinforcing steel because of the coating of corrosion resistant material. The foundation therefore does not act as a single unit but rather as three separate elements. [J.A. 91]

Considerable difficulty is encountered in attempting to construct a Hild wall. [J.A. 93] This is because extreme care must be used to align the vertical steel, the horizontal steel, and the horizontal crossed ties to place them in such close proximity such that they may be welded to produce a Vierendeel truss. Delay is further encountered in the construction of this wall since as each course is laid it is necessary to weld the cross-ties on the vertical steel members. An additional intermediate step called for by the said Hild patent is the waterproofing of the wall. [J.A. 93]

Mr. Franklin testified that the Hild method of construction is not now being used and further did not meet the requirements in California or elsewhere for an earthquake resistant wall. [J.A. 90]

A deposition was also produced by petitioners of the testimony of Thomas N. Jameson. [J.A. 184-195] This witness had personal experience as to the extensive industry acceptance of the petitioners' invention.

The petitioners also introduced 18 exhibits relating to their invention, which are reproduced in part in the Joint Appendix. Certain of these exhibits demonstrate

the dramatic industry recognition of the novelty and utility of the invention, by the change required in the Uniform Building Code to include and approve Pollack and Adams method of construction and the wall produced thereby. [J.A. 75-76, Ex. 9, J.A. 182a] Likewise, the building Codes of both the City of Los Angeles, California, and the City of Long Beach, California, were amended to include and approve these new methods of construction. [J.A. 73-75, 179, Ex. 7, J.A. 181, Ex. 8] The Pollack and Adams invention is also approved for schools by the State Division of Architecture in California and meets the high safety requirements thereof for earthquake resistant construction. [J.A. 73]

None of this testimony was contradicted or rebutted. The defendant relied on prior patents referred to as Hild, Simms and Betzler and the presumption arising from the decisions of the Patent Office.

Reasons for Granting the Writ.

This case raises important questions of constitutional and statutory law involving trials and determinations of patent cases. It involves the construction of Congressional meaning of Title 35, Section 145, U.S. Code, as to a *"trial de novo,"* and when and how a *presumption* of Department of Patents action is overcome.

The petitioners have developed a highly commercially successful grout filled monolithic wall needed and used in earthquake country, particularly California. The Patent Office, which turned down a patent, did not deny either the novelty of the device nor the success commercially of the invention, nor did the trial judge

deny this novelty, usefulness and commercial success. In fact he stated, in refusing to order a patent, that:

> "They have made a remarkable wall. But regardless of how the Court may feel the Court's function is merely this:
>
> "To determine whether or not in view of the evidence here the strong presumption attached to the experts of the Patent Office has been overcome.
>
> "I find it has not been overcome. I find for the defendant and against the plaintiffs."

The trial judge rested on the *presumption* of the action of the Patent Office in rejecting the patent without producing any of the witnesses of the Patent Office to appear and testify or submit themselves to cross-examination and without holding that in a trial *de novo* all of the witness must be produced.

We respectfully contend that such procedure inherently and as construed and applied in this case violates the due process clause of the Fifth Amendment to the Constitution of the United States and is in conflict with recent decisions by this Court holding that the right of confrontation is a right guaranteed by the due process clause of the Constitution of the United States. Further, that the right to a hearing encompasses the right to produce witnesses who can be examined and cross-examined.

We think this is the meaning of the provisions of Title 35, Section 145, and that it has not been construed by this Honorable Court but should be so construed.

In the Legislative History, U.S. Code Congressional & Administrative News for 1952, Vol. 2, Page

2400, in discussing the amendment to the patent law in which Section 145 of Title 35 became a part, it is stated in Senate Report 1979 and House Report 1923 as follows:

> "The next chapter relates to the review of Patent Office decisions.
>
> "The act of 1836 provided, for the first time, for the refusal of patents by officials known as examiners. The legislature was jealous of the rights of the public and provided adequate means of reviewing the action of the Patent Office. In fact, there are now two types of review. The applicant may appeal to a court of appeals especially provided, or he may file suit in the district court against the Commissioner to have his rights adjudicated by the court."

We respectfully submit that this adjudication *de novo* means the production of witnesses and not the mere reliance on action already taken by the Patent Office, and this Court should so hold.

A presumption loses its validity when evidence is produced to overcome that presumption.

Dresser Industries, Inc. v. Smith-Blair, Inc. (C.A. Cal. 1963), 322 F. 2d 878;

Stradar v. Watson, 244 F. 2d 737.

While the historical references to Congress do not set forth the nature of a trial *de novo,* the language of the statute says that the court may adjudicate that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals *as the facts in*

the case may appear. Congress has not, in this or any other section, stated that the facts are determined from a presumption, nor has Congress declared that the actions of the Patent Office have a presumption of validity. Had Congress intended such a presumption to prevail over testimony, it would have done so as it has done in many cases, particularly narcotic cases.

The absence of any such Congressional declaration of the presumption is proof that no such presumption was intended to take place of a trial *de novo* under the well established doctrine of *inclusio unius exclusio alterius*.

In the case of *Tietig v. Ladd*, 228 F. Supp. 637, at 639, the Court said:

> "Initially, it should be stated that this Court is aware of the presumption of correctness that is attached to the decisions of the Patent Office. . . .
>
> "Nevertheless, this is a trial de novo, and if the plaintiffs have shown the Board of Appeals' decision is clearly erroneous or lacks a rational basis, it must find for the plaintiffs.
>
> "As evidence accumulated at trial, it became clear that plaintiffs' method of feeding alloys into a ladle by means of a vibratory pan was indeed a 'new and useful process' within 35 U.S.C. § 101 since no record existed of it ever having been done before."

We paraphrase our case to show that the method of erecting a high strength grout filled metal reinforced brick wall, comprised of the steps of erecting vertical metal reinforcement members; placing a plurality of horizontal layers of pairs of bricks on top of one another

to provide two parallel vertical brick walls so positioned that said metal reinforcement members are disposed approximately midway between the opposed parallel surfaces of said brick walls, each of said pairs of bricks being held in spaced parallel relationship to each other by metal connecting means, said metal connecting means having a strength greater than that of the material of said bricks, and a cross section small in comparison to the length and height of said bricks; and thereafter filling the space between said walls and surrounding said metal connecting means and said vertical metal reinforcement members with grout, thereby forming a unitary monolithic reinforced wall structure. A unitary monolithic wall construction comprising; a plurality of vertical metal reinforcement members; two vertical brick walls having opposed parallel surfaces including a plurality of horizontal layers of pairs of bricks located on top of one another and disposed approximately the same distance from and on opposite sides of said reinforcement members, each pair of said parallel bricks having metal connecting means to hold said bricks in spaced parallel relation to each other, said connecting means having a strength greater than that of the material of said bricks and a cross section small in comparison to the length and height of said bricks; and grout located in the space between the opposed parallel surfaces of said walls and surrounding said connecting means and said vertical metal reinforcement members; and used for earthquake resistant construction and for the first time included in the specifications by cities and a State for their walls. This shows that it is indeed a new and useful process, within 35 U.S.C. Section 101, since there is no record of it ever having been done this way before.

Continuing on with *Tietig v. Ladd, supra,* the Court said:

> "This narrowed the issue to whether, under the language of 35 U.S.C. § 103, 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *.'"

This identical question was raised in the Patent Office in connection with patents known as the Hild, Simms and Betzler patents. The building unit disclosed in Hild is a pair of bricks which are coated with a water and moisture proofing material and which are joined together by bars which are galvanized or coated with a material to prevent corrosion. No grout is placed therein and, in fact, grouting is contrary to the teaching of the said Hild patent which, as respects building walls, expressly teaches a hollow wall. Moreover, as established by the undisputed testimony of the expert called by petitioners, this type of wall precluded bonding and a monolithic structure is not created thereby.

The Betzler patent merely demonstrated that it was old in the art to fill certain hollow walls with concrete. No contention was made by the Patent Office that there was anything in Betzler suggesting that it should be combined with Hild or that a solid wall produced by Betzler, filled with concrete would be monolithic. The undisputed testimony was that a wall produced in accordance with the Betzler patent would be prohibited by the local building ordinances and that it would not meet the building requirements for Washington, D.C. [J.A. 97]:

The other reference was to the Simms patent, and the testimony also was that this did not create monolithic walls because no concrete is poured around the vertical reinforcements. Since there is no bonding between the steel and brick units, each structural member acts as a separate unit.

The present type of wall has met a need for a low cost method differing from any of the other three, none of which was commercially successful. The petitioners' invention has been and is highly successful, especially in earthquake country such as Long Beach, Los Angeles and San Francisco, California, and in Montana.

In *Tietig v. Ladd, supra,* at page 640, the Court said:

> "The question of 'obviousness' has been a continuing source of discussion among the Courts, and is acknowledged by the writers to have no rigid definition. Certain factors are traditionally been influential, however, in determining in particular instances where a given difference between what was known and what was done would have been 'obvious' at the time.
>
> "One of these factors, that when present weighs heavily in favor of patentability, is the satisfaction of a long felt want in the industry to which the invention applies. Kelley et al. v. Coe, 69 App. D.C. 202, 99 L.Ed. 435, and Kaakinen et al. v. The Peelers Company, 301 F.2d 170."

As in the *Tietig* case, the petitioners in this case showed by undisputed evidence that the industry needed this earthquake type of construction since the disastrous earthquakes in San Francisco in 1905 and in Long Beach in 1933 and in Helena, Montana in 1935. So far

as is known, this invention is the only novel and useful invention and commercially successful one that meets this important factor of filling a long felt need.

Commercial success is a factor of positive value in determining whether a patent actually involves novelty and invention.

Hutsler Bros. Co. v. Sales Affiliates, 164 F. 2d 260;

Eastern Venetion Blind Co. v. Acme Steel Co., 188 F. 2d 247 (cert. den. 342 U.S. 824);

Ingersoll Milling Machine Co. v. General Motors, 110 F. Supp. 12 (Aff. 207 F. 2d 42).

In *Kelley v. Coe,* 99 F. 2d 435, the Court said, at page 442, quoting from *Wach v. Coe,* 64 App. D.C. 235, 236, 237, 77 F. 2d 113, 114, 115:

> " 'Where, as here, the new device is also useful and marks a distinct and novel advance in the art, it should receive patent protection. For almost 25 years, as we have seen, patents have been granted in this art on devices that proved to be practically worthless, and yet appellant has been refused a patent on his successful device because the Patent Office has found that, by taking this and that from the unsuccessful patents, the result achieved by appellant could have been accomplished.'
>
> "The Commissioner's argument in the present case comes down to the same result. He contends that anyone skilled in the art could have taken this and that from the various patents and, putting them together, could have devised the Kelley method. But the fact remains that, in the face of a crying need for a new process or method in the in-

dustry, not one of the best engineers in the world, with their attention especially directed to the subject for approximately thirty years, was able to see what Kelley saw, or to produce the result which he produced. The evidence in support of appellants' application establishes beyond doubt their right to the issuance of a patent."

Likewise, in the case at bar, there has been a crying need for a wall that would be protective against earthquakes. The Patent Office took this and that from unsuccessful patents of Hild, Simms and Betzler and yet have refused a patent on the successful device of Pollack and Adams which meets a crying need in earthquake country.

As was said in *Kelley v. Coe,* 99 F. 2d at 440:

"The difference between it and the prior art may not be great in a physical sense, but slight as it may seem to be it was sufficient to achieve success where success had never before been achieved. It was not merely one step in a development process, but was the one step from failure to success. As was said in The Barbed Wire Patent, 143 U.S. 275, 282-283, 12 S.Ct. 443, 446, 36 L.Ed. 154:

" 'Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents, it is the last step that wins. * * * There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.' "

This Court has not heretofore construed the meaning of a trial *de novo* as set forth in Title 35, Section 145. We respectfully contend that the language of a trial *de novo* means producing all of the witnesses available on the subject anew. To follow the practice in this case would be to hold that a trial *de novo* merely meant that the petitioner should bring in his witnesses and not the Patent Office or the opponents to the patent. This is not the meaning of a trial *de novo.*

A *de novo* trial in an appellate court is a trial had as if no action whatever had been instituted below.

Carcher v. Gelden, 32 Atl. 223, 8 Hous. 163;

Archer v. High, 9 So. 2d 647, 648, 193 Miss. 361;

Lone Star Gas Co. v. State, 153 S.W. 2d 681, 692;

Reck v. Reck, 46 N.E. 2d 429, 430.

"*De novo*" means fresh or anew or for a second time, and *de novo* trial in a reviewing court is trial had as if no action whatever had been instituted in the court below.

In re Hayes, 135 S.E. 2d 645, 649;

Wilson v. Morris, 369 S.W. 2d 402;

Foster v. Carson School District No. 301, 63 Wash. 2d 29, 385 P.2d 367.

In *Southern Canal Co. v. State Board of Water Engineers,* 159 Tex. 227, 318 S.W. 2d 619, 622, the court held that the meaning of a *de novo* trial, where that term is used to describe a retrial of a matter of controversy theretofore tried by another tribunal, is the nullification of the judgment or order of the first tri-

bunal and retrial of the issues on which judgment or order was founded and when jurisdiction of the second tribunal attaches the order of the first tribunal is not merely suspended but is nullified.

This is the general meaning and understanding of "*de novo*" and therefore the action or order of the Patent Office denying a patent is not merely suspended, but nullified under the terms of the statute and there is no presumption of regularity of a nullified order or determination.

See also:

In re Pines Estate, 16 Ill. App. 2d 574, 149 N.E. 2d 787;

In re Betts' Estate, 2 Ill. App. 2d 453, 119 N.E. 2d 801.

In *Hiner v. Wenger,* 91 S.E. 2d 637, 639, 197 Va. 869, the court held that where the statute directed a trial *de novo* on appeal that the court was required to hear or try the case on its merits, from beginning to end, as if no trial or hearing had been held by the Board and without any presumption in favor of the Board's decision.

In *Hiner v. Wenger, supra,* in discussing the meaning of the language that the court "*shall hear the matter de novo*", this means that the court must hear or try the case on the merits, from beginning to end, as if no trial or hearing had been held by the Board and without any presumption in favor of the Board's decision. (30 C.J.S.)

We submit, therefore, that the meaning of Congress was the ordinary, legal meaning of the words "*de novo*" as defined in many cases, and did not mean that

the decision could rest on the presumption of validity attaching to the Patent Office adjudications but that that adjudication must be set aside and it must be heard *de novo*. This Court should grant a hearing to determine the constitutional issue of the validity of the presumption as denying due process of law guaranteed by the Fifth Amendment.

The presumption of validity of the Commissioner's determination denied to the petitioners the right to cross-examine the experts upon which the presumption is based. A proceeding which denies confrontation of witnesses and an opportunity to cross-examine violates the fundamental principles of due process of law.

Furthermore, such a proceeding is incongruous, partial, arbitrary and capricious. It denied to the court the opportunity to weigh all of the evidence and it denied to the court the right to see and hear the witnesses before it acted and to give such weight to the witnesses as the court determined. In *Powell v. Alabama,* 287 U.S. 45, the famous words of Webster are quoted, that "the law of the land" is intended "a law which hears before it condemns."

Title 35, Section 145, U.S. Code, makes no provision for the admission of any Patent Office records and makes no provision as to the effect of the records in the Patent Office. It makes no provision for the production of the experts of the Patent Office or the examiners of the Patent Office or examination or cross-examination. Thus the proceedings in the Patent Office, which are *ex parte* or *in camera,* are taken as determinative of the issues without the right or opportunity of cross-examination.

In *Pointer v. Texas,* 380 U.S. 400, 13 L. ed. 923, this Court points out that the Sixth Amendment affords an accused the right to be confronted by the witnesses against him as an essential to fair trial and is made obligatory on the States under the Fourteenth Amendment. This right of confrontation and cross-examination is as equally important in patent cases. A man's whole lifetime effort may be obliterated by the failure to produce the witnesses and be confronted by those purported examiners or experts who ruled against him.

As stated in *Pointer v. Texas, supra:*

> "And probably no one, certainly no one experienced in the trial of lawsuits, would deny the value of cross-examination in exposing falsehood and bringing out the truth in the trial of a criminal case. See, *e.g.* 5 Wigmore, Evidence § 1367 (3d ed. 1940). The fact that this right appears in the Sixth Amendment of our Bill of Rights reflects the belief of the Framers of those liberties and safeguards that confrontation was a fundamental right essential to a fair trial in a criminal prosecution."

We say in any trial the right of confrontation is one of the fundamental guarantees of fair trial.

Quoting again, Mr. Justice Stone, writing for the Supreme Court in *Alford v. U.S.,* 282 U.S. 687, declared that "The right of cross-examination is 'one of the safeguards essential to a fair trial' ". What is said in *Pointer v. Texas, supra,* and in *Douglas v. Alabama,* 380 U.S. 415, 13 L.ed. 2d 934, is equally applicable in patent cases.

In *Douglas v. Alabama, supra,* this court said, in headnote 3:

> "The primary object of the confrontation clause of the Sixth Amendment is to prevent depositions or *ex parte* affidavits being used against an accused in lieu of a personal examination and cross-examination of the witnesses."

But there is no cross-examination in the proceedings in the Patent Office, nor are the papers produced, nor does the trial judge in a patent case have an opportunity for appearance testimony so that he, the judge, might look at the witness and judge by his demeanor on the stand and the manner in which he gives his testimony whether he is worthy of belief (156 U.S. 237, 242, 243, 39 L.ed. 409, 411). Nor is the so-called examiner or expert in the Patent Office subject to examination as to a foundation as to his ability or knowledge or whether he has accurately applied it, nor could the court as, within reason and certainty, that the Patent Office would have decided the case as it did after such witnesses had been cross-examined.

In *United States v. Gainey,* 380 U.S. 63, 13 L.ed. 658, this Court upheld a statutory presumption regarding the presence of a person at a still and a full discussion is contained therein by Mr. Justice Black upon statutory presumptions.

But in the instant case there is no statutory presumption. Congress omitted passing such a presumption and therefore, it must be assumed that the trial *de novo* meant exactly what it said.

A presumption has been defined by statute as "A deduction which the law expressly directs to be made from particular facts."

Wigmore says:

"It must be kept in mind that the peculiar effect of a presumption 'of law' (that is, the real presumption) is merely to invoke a rule of law compelling the jury to reach the conclusion *in the absence of evidence to the contrary* from the opponent. If the opponent *does* offer evidence to the contrary (sufficient to satisfy the judge's requirement of some evidence), the presumption disappears as a rule of law, and the case is in the jury's hands free from any rule." Wigmore, Evidence, § 2491 (3d ed.)

In *Smith v. Asbell,* 2 Strobh. 141, 147:

"Presumptions . . . are artificial rules which have a legal effect independent of any belief, and stand in the place of proof *until the contrary be shown.*"

And quoting *Mockowik v. Kansas City, St. J. & C.B. Co.,* 196 Mo. 550, 571, 94 S.W. 256:

" 'Presumptions,' as happily stated by a scholarly counselor, 'ore tenus,' in another case, 'may be looked on as the bats of the law, flitting in the twilight but disappearing in the sunshine of actual facts.' "

In *Kath v. Kath,* 238 Minn. 120, 55 N.W. 2d 691, 693, the court said:

"A presumption, however, is merely a procedural device and dictates a decision only where there is an entire lack of competent evidence to the contrary and the very moment substantial countervailing evidence appears from any source it ceases to have any function and vanishes completely from the cause as if it had never existed."

In *French v. Edwards,* 80 U.S. 506, 13 Wall. 506, 20 L. Ed. 702, this Court said:

> "Presumptions are indulged to supply the place of that which is not apparent and not to give a new character to that which is seen to be defective."

Where, as here, then, there was positive evidence regarding the invention, its great usefulness, its answer to an important need in earthquake country, its commercial success, testified to by an expert witness and by a deposition of another expert, it is respectfully submitted that no presumption of the Patent Office remained and that the petitioners are entitled to their patent.

This case raises an important question of constitutional and statutory law with reference to patent cases and it is important that a hearing be granted and the judgments and orders below reversed and an order made by this Court, directing the Commissioner of Patents to grant petitioners a patent.

Respectfully submitted,

MORRIS LAVINE,
Attorney for Petitioners.

APPENDIX A.

Decision by the United States District Court for the District of Columbia.

The Court: Well, I have listened with great interest to the testimony of the witness on the stand and, of course, in this type of a *de novo* bill the testimony and all [98] of the evidence in it must show clearly that the experts in the Patent Office were wrong.

I haven't heard one word in the record before me that it would not be obvious to one skilled in the art knowing the prior art as it is to do exactly what these men have done.

They have made a remarkable wall. But regardless of how the Court may feel the Court's function is merely this:

To determine whether or not in view of the evidence here the strong presumption attached to the experts of the Patent Office has been overcome.

I find it has not been overcome. I find for the defendant and against the plaintiffs.

The defendant will present proposed findings of fact, conclusions of law and an order.

Court now stands adjourned until tomorrow morning at 10:00 o'clock.

The Deputy Marshal: This Honorable Court stands adjourned until 10:00 o'clock tomorrow morning.

(Whereupon, at 2:40 p.m. the trial of Civil Action No. 503-63, Pollack & Adams v. Ladd, Comm'r of Patents, was concluded.)

APPENDIX B.

United States Court of Appeals for the District of Columbia Circuit. No. 18801.

Sheldon L. Pollack, et al., Appellants, v. David L. Ladd, Commissioner of Patents, Appellee.

Appeal from the United States District Court for the District of Columbia.

Decided April 8, 1965

Mr. Elwood S. Kendrick, of the bar of the Supreme Court of California, *pro hac vice,* by special leave of court, with whom *Messrs. E. H. Mosher* and *A. Donald Stolzy,* were on the brief, for appellants.

Mr. George C. Roeming, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief, for appellee.

Before Wilbur K. Miller, *Senior Circuit Judge,* and Danaher and McGowan, *Circuit Judges.*

Danaher, *Circuit Judge:* After adverse rulings by the tribunals of the Patent Office, the appellants here asked the District Court to authorize the Commissioner to issue a patent on their application, serial No. 825,124. Particularly involved were the appellants' Claim 17 respecting a method of erection of a high-strength grout-filled metal-reinforced brick wall and Claim 18 describing a relatively inexpensive wall constructed in accordance with the method of Claim 17. After the *de novo* trial authorized by 35 U.S.C. § 145 (1958), the District Judge rendered an opinion pursuant to which judgment was entered for the Commissioner.

The experienced and able trial judge concluded that each of the claims at issue was directly readable upon prior art. Our examination of the entire record has persuaded us that we are bound to affirm.

There is no question that the appellants taught an improved method of erecting a highly useful grout-filled monolithic building wall. The results in actual use were seen to be excellent, indeed the evidence showed a high degree of commercial success. Important though such factors may be in a close case, of themselves they do not establish patentability. The trial judge reasonably could have concluded that there simply was an inadequate showing of invention.

We are bound to affirm.[1]

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[1]Standard Oil Development Co. v. Marzall, 86 U.S.App.D.C. 210, 214, 181 F.2d 280, 284 (1950); cf. L-O-F Glass Fibers Company v. Watson, 97 U.S.App.D.C. 69, 76, 228 F.2d 40, 47 (1955).